

REMARKS

Rejections based on Lauper

Applicants respectfully assert that Lauper is not prior art. Applicants' patent application was filed on 06/09/00, which is before the date of 11/29/00 that determines whether the pre-AIPA or post-AIPA version of 35 U.S.C. §102(e) is used. Because the application was filed prior to 11/29/00, the pre-AIPA version of 35 U.S.C. §102(e) must be used. Under the pre-AIPA version of 35 U.S.C. §102(e), the prior art date of Lauper is the date it was filed in the U.S., namely 02/25/02. Because applicants' patent application was filed on 06/09/00, which predates the prior art date of Lauper, Lauper is not prior art, and cannot be applied to the pending claims. In a telephone conference with the Examiner on 04/27/04, applicants' attorney Derek Martin laid out the case above for removing Lauper as prior art. The Examiner agreed that Lauper is not prior art under pre-AIPA 35 U.S.C. §102(e). As a result, applicants respectfully request reconsideration of all of the Examiner's rejections that are based on Lauper.

Rejection of claims 11 and 28 under 35 U.S.C. §102(e) as being anticipated by Lauper

The Examiner rejected claims 11 and 28 under 35 U.S.C. §102(e) as being anticipated by Lauper. Lauper is not prior art for the reasons given above. As a result, applicants hereby request reconsideration of the Examiner's rejection of claims 11 and 28 under 35 U.S.C. §102(e) based on Lauper.

Rejection of claims 1-2, 6, 17-18, 22 and 30-33 under 35 U.S.C. §103(a) as being unpatentable over Lauper in view of Kuwahara

The Examiner rejected claims 1-2, 6, 17-18, 22 and 30-33 under 35 U.S.C. §103(a) as being unpatentable over Lauper in view of Kuwahara. Lauper is not prior art for the reasons given above. As a result, applicants hereby request reconsideration of the Examiner's rejection of claims 1-2, 6, 17-18, 22 and 30-33 under 35 U.S.C. §103(a) based on the combination of Lauper and Kuwahara.

Rejection of claims 3-5, 7-8, 19-21 and 23-24 under 35 U.S.C. §103(a) as being unpatentable over Lauper and Kuwahara and further in view of Finke-Anlauff

The Examiner rejected claims 3-5, 7-8, 19-21 and 23-24 under 35 U.S.C. §103(a) as being unpatentable over Lauper and Kuwahara and further in view of Finke-Anlauff. Lauper is not prior art for the reasons given above. As a result, applicants hereby request reconsideration of the Examiner's rejection of claims 3-5, 7-8, 19-21 and 23-24 under 35 U.S.C. §103(a) based on the combination of Lauper, Kuwahara and Finke-Anlauff.

Rejection of claims 13-16 under 35 U.S.C. §102(e) as being anticipated by Bijanki

The Examiner rejected claims 13-16 under 35 U.S.C. §102(e) as being anticipated by Bijanki. In the rejection of claims 13-14, the Examiner states:

... Bijanki discloses a telephone system comprising:
... a processor coupled to the portable phone that determines from the position detector the geographical position of a portable phone, and that rings the portable phone when the assigned telephone number of the defined region is called if the portable phone is within the defined geographical region (see col. 5 lines 6-15).

The language in the rejection does not match the language in claim 13 as amended. Claim 13 recites “a processor *in* the portable phone”, not a processor *coupled to* the portable phone, as recited by the Examiner. The processor cited by the Examiner at col. 5 lines 6-15 of Bijanki is the MSC 114 in FIG. 2 of Bijanki, which is clearly separate from the mobile unit 108. For this reason, the processor cited by the Examiner in Bijanki does not read on the “processor in the portable phone” recited in claim 13. Nowhere does Bijanki teach or suggest logic within the phone itself that rings the portable phone when the assigned telephone number of the defined region is called if the portable phone is within the defined geographical region. For this reason, claim 13 is allowable over Bijanki.

Claims 14-16 depend on claim 13, which is allowable for the reasons given above. As a result, claims 14-16 are allowable as depending on an allowable independent claim. Applicants respectfully request reconsideration of the Examiner’s rejection of claims 13-16 under 35 U.S.C. §102(e).

Rejection of claims 13-15 and 30-32 under 35 U.S.C. §103(a) as being unpatentable over Alperovich A in view of Alperovich B

The Examiner rejected claims 13-15 and 30-32 under 35 U.S.C. §103(a) as being unpatentable over Alperovich A in view of Alperovich B. Claim 13 was previously amended to specify that the processor is in the portable phone. The functions cited in the art as allegedly reading on the processor are functions performed by the phone system (specifically, the base station), not by the phone itself. For this reason, claim 13 as amended is allowable over the combination of Alperovich A and Alperovich B.

In the Response to Arguments section of the pending office action, the Examiner states:

As per claims 13-15, in page 15 of the Remarks, the Applicant further argues that claim 13 has been amended to specify that the processor is in the portable phone, and the functions cited in the prior art as allegedly reading on the processor are performed by the phone system not by the phone itself. It appears that the Applicant overlooks the teaching of the use of GPS within a mobile station to determine the position of the mobile taught by Alperovich (448) teaches. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Alperovich(a) with a position detector in the portable phone, as taught by Alperovich(b), for the purposes of increasing the resolution and accuracy of the position detector to "within about \pm 10 feet."

It is clear from the Examiner's language above that the Examiner has misunderstood Applicants' argument. Applicants were not addressing the position detector when referencing the "processor" in the remarks. Applicants were addressing the processor expressly recited in claim 13, namely:

... a processor in the portable phone that determines from the position detector the geographical position of the portable phone, and that rings the portable phone when the assigned telephone number of the defined region is called if the portable phone is within the defined geographical region.

In the rejection of claim 13, the function of the processor in the claim is mapped to the teachings at col. 6 line 43 through col. 7 line 2 of Alperovich A. This language includes the following excerpt:

Thus, when a dispatcher calls this number the cellular telephone network 145 accesses the home location register 120 database to determine all mobile stations 155 included in the particular taxi dispatch service group which are in the service area 100 serviced by the mobile switching center 110 in geographical proximity to the airport. The call is then established between these taxis and the dispatcher.

Thus, the function cited by the Examiner in Alperovich A is function that is provided in the cellular telephone network 145, not in the mobile units themselves. Applicants respectfully assert that Alperovich A expressly teaches away from the mobile units performing these functions by the fact that the mobile telephone system itself performs

those functions. As a result, there is no need for the mobile units in Alperovich A to perform the function of the processor recited in claim 13. Because Alperovich A does not teach or suggest the processor recited in claim 13, namely “a processor *in the portable phone* . . . that rings the portable phone when the assigned telephone number of the defined region is called if the portable phone is within the defined geographical region”, claim 13 is allowable over the combination of Alperovich A and Alperovich B.

Claim 30 was previously amended to recite that the portable phone causes itself to ring if the detected geographical position of the portable phone is within the defined geographical region. In the cited art, this decision is made by the mobile phone network, not the portable phone. For this reason, claim 30 as amended is allowable over the combination of Alperovich A and Alperovich B.

Claims 14-15 and 31-32 depend on claims 13 and 30, respectively, which are allowable for the reasons given above. As a result, claims 14-15 and 31-32 are allowable as depending on allowable independent claims. Applicants respectfully request reconsideration of the Examiner’s rejection of claims 13-15 and 30-32 under 35 U.S.C. §103(a) based on the combination of Alperovich A and Alperovich B.

Rejection of claim 27 under 35 U.S.C. §103(a) as being unpatentable over Kuwahara and Alperovich B and further in view of Fitch

The Examiner rejected claim 27 under 35 U.S.C. §103(a) as being unpatentable over Kuwahara and Alperovich B as applied to claim 17, and further in view of Fitch. The Examiner’s rationale for rejecting claim 17 changed from the first office action to the second (pending) office action. In the second office action, the rejection of claim 17 was based on the combination of Lauper and Kuwahara, not on the combination of Kuwahara and Alperovich B, as stated by the Examiner. Because claim 17 was not rejected based

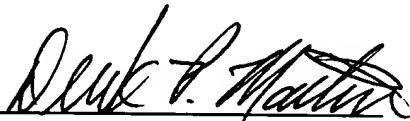
on Kuwahara and Alperovich B, as stated by the Examiner, the Examiner has failed to establish a *prima facie* case of obviousness for claim 27 under 35 U.S.C. §103(a).

If the Examiner intended to base the rejection of claim 27 on the combination of Lauper and Kuwahara used to reject claim 17, the rejection still fails. Lauper is not prior art for the reasons given above, so any rejection of claim 17 based on the combination of Lauper and Kuwahara is improper. Applicants respectfully request reconsideration of the Examiner's rejection of claim 27 under 35 U.S.C. §103(a).

Conclusion

In summary, none of the cited prior art, either alone or in combination, teach, support, or suggest the unique combination of features in applicants' claims presently on file. Therefore, applicants respectfully assert that all of applicants' claims are allowable. Such allowance at an early date is respectfully requested. The Examiner is invited to telephone the undersigned if this would in any way advance the prosecution of this case.

Respectfully submitted,

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